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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,317	03/02/2004	Jay S. Walker	03-019	1814
22927	7590	08/22/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			NGUYEN, BINH AN DUC	
			ART UNIT	PAPER NUMBER
			3713	
DATE MAILED: 08/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/791,317	WALKER ET AL.	
	Examiner Binh-An D. Nguyen	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 May 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-15 and 17-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/14/05; 2/24/05</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. The Amendment filed May 15, 2005 has been received. According to the Amendment, the specification has been amended; claims 3 and 16 have been canceled; and claims 2 and 12 have been amended. Currently, claims 1, 2, 4-15, and 17-20 are pending in the application. Acknowledgment has been made.
  
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the illustrations of the popcorn icon being utilized and transformed on a matrix in the slot machine game and as claimed in claim 1; illustration of the matrix of the game in claims 1, 2, 3-15, and 17-20; illustration of displaying an image which moves from a starting position to the respective determined position in claims 1, 2, and 12; illustration of the outcomes having respective positions which defines a column of claims 6, 19, and 20; and illustrations of method steps for the game process of claims 1, 2, 4-15, and 17-20 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

Art Unit: 3713

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note that, the applicant is suggested to refer to the illustrations of popcorns in the video game as shown in figures 3, 4, 8, and 9-17 of the provisional application 60/452166 to overcome this objection.

3. The disclosure is objected to because of the following informalities:

In the specification (page 12, line 12), a comma (,) should be inserted after "e.g." The conjunction "and / or" (with spaces) on page 5, line 4; page 8, line 27; page 10, lines 21, 22, 32; page 11, line 7; and page 17, lines 17, 26, and 30 should be changed to "and/or".

Note, other appropriate corrections regarding such typos throughout the specification should be made.

Appropriate correction is required.

Art Unit: 3713

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Baerlocher et al. (6,319,124).

Baerlocher et al. teaches a gaming method for slot machine comprising: generating an outcome for a slot machine, the outcome representing a plurality of reel symbols; displaying a common icon (50) for each symbol (Fig.3); determining, for each symbol, a respective position on a matrix, in which the matrix is defined by a plurality of rows and a plurality of columns, and in which each respective position is defined by one of the rows and one of the columns, displaying, for each common icon (50), a respective image of the common icon (50) transforming into the corresponding symbol (Figs. 4-6); displaying, for each symbol, an image which moves from a starting position (position prior to the game started) to the respective determined position (3:9-20); displaying the symbols on a display device based on the determined positions; and determining a payout based on rows and columns of the determined positions.

Baerlocher et al. does not explicitly teach a slot machine game having a popcorn icon, however, this is a design choice since replacing the common icons with the popcorn icon(s) does not bring unexpected result to the game. Note that, both the common icon 50 and the popcorn icon act as a mask or represent an unknown value prior to their transformation into certain symbol.

It would have been obvious to a person of ordinary skill in the art to modify Baerlocher et al.'s game by replacing the commons icons with the popcorn icons to enhance slot machine attraction.

7. Claims 2, 4-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Baerlocher et al. (6,319,124).

Baerlocher et al. teaches a gaming method for slot machine comprising: generating an outcome for a gaming device, the outcome representing a plurality of reel symbols (Fig.4); determining a position on a matrix in which the matrix is defined by a plurality of rows and a plurality of columns, and in which each respective position is defined by one of the rows and one of the columns; displaying the outcome on a display device based on the determined position (2:34-40); and determining a payout based on the determined position (1:44-2:47); displaying an image which moves (transforms) from a starting position (position prior to the game started) to the determined position (3:9-20); generating a plurality of outcomes, in which determining a position on a matrix comprises determining a plurality of positions on the matrix, and further comprising: generating a payout based on the plurality of determined positions; generating the

Art Unit: 3713

payout based on outcomes having respective positions which define a row (Fig. 4); determining a position on a matrix comprises randomly determining the position; determining a position on a matrix comprises determining the position based on at least one rule (5:19-23), and a determined position of another outcome; a symbol of the outcome and a symbol of the second outcome are identical; dividing the outcome into a plurality of components (individual component selected by the player); and displaying an image that depicts the components forming the outcome (Fig. 10); determining the payout based on identical symbols having respective determined positions which define a column (Fig. 9).

8. Applicant's arguments filed May 13, 2005 have been fully considered but they are not persuasive.

Applicant's arguments regarding improper drawings objection (applicant's remarks, page 19, line 4 to page 22, line 11) is deemed not to be persuasive. The applicant is suggested to refer to the illustrations of the transformation of popcorns as shown in figures 3, 4, 8, and 9-17 of the provisional application 60/452166, in which this application claimed priority, to overcome this objection.

Further, Applicant's arguments regarding Baerlocher not teaching the limitations of displaying an icon of a popcorn for each symbol (applicant's remarks regarding claim 1, page 28, lines 18-21) are deemed not to be persuasive since Baerlocher discloses transforming common icons 50 into certain symbols (3:2-37, 6:6-42, and Figs. 3-5).

Note that, both the common icon 50 of Baerlocher and the applicant's popcorn icon act

as a mask or represent an unknown value prior to their transformation into certain symbol, they are equivalent and are considered as a design choice since replacing the common icons with the popcorn icon(s) does not bring unexpected result to the game.

Furthermore, Applicant's arguments regarding claims 1, 2, and 12 that Baerlocher not teaching the limitations of *displaying, for each symbol, an image which moves from a starting position to the respective determined position* (applicant's remarks regarding claim 1, page 28, line 22 to page 29, line 5; and claims 2 and 12, page 29, lines 6-19) are deemed not to be persuasive since Baerlocher discloses the animated symbols which moves (animates, e.g., moving or transforming, 3:9-20) from a starting position (e.g., move upwards, downwards, etc.) to the respective determined position. Note that, since a starting position is not clearly defined, e.g., inside or outside the matrix, this limitation is broadly interpreted as the symbols characters being animated or moved within the matrix.

9. Applicant's arguments, see applicant's remark, pages 24-27, filed May 13, 2005, with respect to rejection under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. The rejection of 6, 19, and 20 has been withdrawn.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3713

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BN

  
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EXAMINER  
TC3700